

UNITED STATES DISTRICT COURT
DISTRICT OF PUERTO RICO

ITC FINANCIAL SERVICES, LLC,
et al.,

Plaintiffs,

v.

R-G PREMIER BANK OF PUERTO RICO,

Defendant.

Civil No. 05-2130 (JAF)

ORDER FOR PRELIMINARY INJUNCTION

On October 27, 2005, ITC Financial Services, LLC, PRE Holdings Inc., ITC Financial Licenses, Inc., and PRE Solutions de Puerto Rico, Inc., (collectively "Plaintiffs") filed an Amended Complaint for a Temporary Restraining Order, Injunctive Relief and Damages (Docket Document No. 3) against Defendant R-G Premier Bank of Puerto Rico ("R-G"), seeking injunctive relief and damages for trademark infringement and unfair competition. On that same date, Plaintiffs filed a Motion for Temporary Restraining Order and Preliminary Injunction (Docket Document No. 4) and a Memorandum in Support of their Motion for Temporary Restraining Order and Preliminary Injunction (Docket Document No. 5) against Defendant R-G.

On November 16, 2005, this court held a hearing to consider whether to grant the injunctive relief sought by the Plaintiffs. According to the evidence presented, the court makes the following findings:

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1 1. Plaintiffs have used the mark MIO™ to promote their prepaid
2 card services, including their MIO Card in the United States since
3 September 2004. Plaintiffs have been promoting the MIO™ Card in
4 Puerto Rico for nearly a year and are on the verge of launching the
5 MIO™ Card to retailers; they anticipate that the card will be
6 available in retail stores in Puerto Rico in the next few months.

7 2. R-G is currently engaged in an extensive advertising
8 campaign using the mark "MIO" and/or "Mio" to promote banking
9 services which include products that compete with Plaintiffs' MIO™
10 Card, such as R-G's Visa Gift Card, Visa Travel Money Card, and other
11 banking cards.

12 3. Not only were Plaintiffs promoting the MIO™ Card in Puerto
13 Rico for months before R-G launched its campaign, but R-G actually
14 knew about the MIO™ Card and its pending availability in Puerto Rican
15 retail stores when it launched its campaign. Indeed, representatives
16 of Plaintiffs met with R-G's Vice-President of Retail Banking in
17 September 2004, to determine if R-G could assist Plaintiffs in
18 issuing the MIO™ Card in Puerto Rico.

19 4. Furthermore, De la Cruz & Associates, the firm responsible
20 for R-G's MIO advertising campaign, never conducted a due diligence
21 and/or background check on the mark "MIO" and/or "Mio" before R-G's
22 launch of its MIO campaign.

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1 5. When R-G launched its MIO advertising campaign, Plaintiffs
2 immediately began experiencing actual confusion between their MIO™
3 mark and card and R-G's MIO campaign.

4 After carefully considering the evidence presented, this court
5 finds that Plaintiffs are entitled to their requested injunctive
6 relief due to their likelihood to prevail on the merits of their
7 trademark infringement and unfair competition claims. Plaintiffs
8 have preliminarily demonstrated that R-G's use of the MIO mark has
9 resulted in a substantial likelihood of confusion, resulting in both
10 a likelihood of success on the merits, as well as irreparable injury.
11 Plaintiffs have shown that they use, and thereby own the MIO™ mark,
12 that R-G is using that same mark, and that R-G's use is likely to
13 confuse the public, thereby harming Plaintiffs. Furthermore, when
14 similar, let alone, identical marks are used to promote similar
15 products, a likelihood of confusion will result. The parties are
16 also using the same advertising channels to reach the same consumers.
17 Since Plaintiffs have demonstrated a substantial likelihood of
18 success on the merits, irreparable harm is presumed. Moreover, in
19 addition to the presumption of irreparable harm, Plaintiffs
20 demonstrated irreparable harm to their goodwill and reputation.
21 Finally, the court finds that Plaintiffs' injury outweighs any harm
22 which granting Plaintiffs' requested injunctive relief would cause R-
23 G, and Plaintiffs' requested injunctive relief serves the public
24 interest in preventing consumer confusion.

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1 Accordingly, this court enters an Order for Preliminary
2 Injunction pursuant to Federal Rule of Civil Procedure 65(b), against
3 Defendant R-G and each of its divisions, related companies, officers,
4 directors, agents, servants, employees, and all those acting in
5 concert or participation with it or them, ordering them to cease and
6 desist from:

- 7 (1) using or authorizing the use of the "MIO" and/or "Mio"
8 mark, or any variations of the term without regard to
9 capitalization of any of its letters or any other
10 confusingly-similar mark, design or designation thereto, in
11 any form, or in any manner;
- 12 (2) passing off or inducing or enabling others to sell or pass
13 off any goods or services which are not authorized by
14 Plaintiffs as and for goods or services sponsored or
15 endorsed by, associated or affiliated with Plaintiffs;
- 16 (3) unfairly competing with, injuring the business or
17 reputation of, or damaging the goodwill of Plaintiffs in
18 any manner and any other representation that falsely
19 describes or represents the nature, characteristics,
20 qualities or benefits of R-G's goods or services, and any
21 association or approval of those goods by Plaintiffs, and;
- 22 (4) falsely representing themselves as being connected with,
23 sponsored by or associated with Plaintiffs.

